

### **REMARKS/ARGUMENTS**

Applicant has received and carefully reviewed the Office Action mailed on January 28, 2010. Claims 1, 6, 10, 19, 23, 28, and 36 have been amended and claims 45-63 have been canceled. Claims 3-5, 12-14, 21, 22, 30, 31, 38, 39, and 44 are withdrawn from consideration as being directed to a non-elected species. Applicant respectfully traverses all assertions and rejections made in the Office Action. Favorable consideration of the above amendments and the following comments is respectfully requested.

#### **Claim Rejections – 35 U.S.C. 102**

Claims 10, 15-17, 28, 32-34, 36, and 40-42 were rejected under 35 U.S.C. 102(e) as being anticipated by Johansen et al. (U.S. Patent No. 7,303,533). Applicant respectfully traverses the rejection. Independent claim 10, as amended, recites:

10. (Currently Amended) An intracorporeal device comprising:
- a) a helically wound coil having a plurality of windings forming a coil length and defining a longitudinal coil axis extending along the coil length; and
  - b) a plurality of joining elements disposed longitudinally along the coil length, wherein each joining element only couples two or more coil windings, and wherein ~~at least one of the plurality of a first~~ joining element[[s]] is longitudinally offset from ~~at least one other a second~~ joining element such that the first and second joining elements do not overlap longitudinally along the coil length as viewed from a direction transverse to the coil axis.

Johansen et al. do not appear to teach the identical structure recited in the claim. Johansen et al. appear to teach embodiments having a plurality of welds that are disposed such that a majority of the welds overlap. See FIGS. 2, 4, and 5. Johansen et al. thus cannot be seen to anticipate independent claim 10 and the claims dependent thereon.

Independent claim 28, as amended, recites:

28. (Currently Amended) A medical device comprising:
- a) an elongate shaft having a proximal end and a distal end;
  - b) a helically wound coil having a plurality of windings having an outer perimeter and forming a coil length disposed about a portion of the distal end of the elongate shaft; and

c) a plurality of joining elements disposed on only a portion of the outer perimeter and along the coil length, wherein each joining element couples two or more coil windings, and wherein ~~at least one of the plurality of joining elements is disposed more distal than at least one other joining element~~ the plurality of joining elements are disposed in two or more series, wherein the joining elements of each series are spaced apart along a longitudinal line, and the joining elements of adjacent series do not overlap longitudinally.

Johansen et al. do not appear to teach the identical structure recited in the claim. Johansen et al. do not appear to teach a plurality of joining elements disposed in two or more series spaced apart along a longitudinal line. Instead, Johansen et al. appear to teach single welds along a longitudinal line, and longitudinally overlapping welds. See FIGS. 2, 4, and 5. Johansen et al. thus cannot be seen to anticipate independent claim 28 and the claims dependent thereon.

Independent claim 36, as amended, recites:

36. (Currently Amended) A guidewire comprising:
- a) an elongate shaft having a proximal end and an opposing distal end;
  - b) a helically wound coil having a plurality of windings having an outer perimeter and forming a coil length disposed about a portion of the distal end; and
  - c) a plurality of joining elements disposed on only a portion of the outer perimeter and along the coil length, wherein each joining element couples two coil windings, and wherein ~~at least one of the plurality of joining elements are spaced apart along a plurality of longitudinal lines, wherein joining elements in adjacent lines have is disposed closer to the proximal end than at least one other joining element with no longitudinal overlap.~~

Johansen et al. do not appear to teach the identical structure recited in the claim. Johansen et al. do not appear to teach a plurality of joining elements spaced apart along a plurality of longitudinal lines, wherein joining elements in adjacent lines have no longitudinal overlap. As discussed above, Johansen et al. appear to teach single welds along a longitudinal line, and longitudinally overlapping welds. See FIGS. 2, 4, and 5. Johansen et al. thus cannot be seen to anticipate independent claim 36 and the claims dependent thereon.

For at least the reasons set forth above, Johansen et al. fail to teach the identical structure as recited in the claims and thus cannot be deemed to anticipate the claims. Further,

there is no rational reason for one of ordinary skill in the art to modify Johansen et al. to achieve the claimed structure. Reconsideration and withdrawal of the rejection are respectfully requested.

### **Claim Rejections – 35 U.S.C. 103**

Claims 1, 6-9, 11, 18, 29, 35, 37, and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. (U.S. Patent No. 7,303,533). Applicant respectfully traverses the rejection. Independent claim 1, as amended, recites:

1. (Currently Amended) An intracorporeal device comprising:
  - a) a helically wound coil having a plurality of windings forming a coil length and defining a longitudinal coil axis extending along the coil length; and
  - b) at least ten joining elements disposed along the coil length, wherein each joining element is located at a longitudinal position along the coil length relative to the coil axis and couples two or more coil windings, wherein a first series of joining elements are spaced apart longitudinally along the coil length, and a second series of joining elements are spaced apart longitudinally along the coil length, wherein the longitudinal positions of at least one of the at least ten the joining elements in the first series are transversely is longitudinally offset from the longitudinal positions of at least one other the joining elements in the second series along the coil length, such that the joining elements in the first series are staggered relative to the joining elements in the second series along the coil length.

Johansen et al. do not appear to teach the structure recited in the claim. As discussed above, Johansen et al. appear to teach single welds along a longitudinal line, and longitudinally overlapping welds. See FIGS. 2, 4, and 5. Johansen et al. thus fails to teach the structure of claim 1. Further, there is no rational reason for one of ordinary skill in the art to modify Johansen et al. to achieve the claimed structure. The only such motivation is found in Applicant's specification, which is an error. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 19, 20, and 23-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. (U.S. Patent No. 7,303,533) in view of Erickson et al. (U.S. Patent No. 5,664,580). Applicant respectfully traverses the rejection. Independent claim 19, as amended, recites:

19. (Currently Amended) An intracorporeal device comprising:
- a) a helically wound coil having a plurality of windings having an outer perimeter and forming a coil length; and
  - b) a plurality of joining elements disposed on only a portion of the outer perimeter and along the coil length, wherein each joining element couples two or more coil windings, wherein the plurality of joining elements are disposed on the outer perimeter in a series of circumferential rings, each ring being spaced longitudinally from adjacent rings, each ring having one or more joining element spaced apart around the circumference of the coil, wherein the joining elements in each ring are substantially aligned longitudinally, and wherein at least one of the plurality of joining elements is longitudinally spaced apart from at least one other joining element, wherein the at least one joining element does not couple to any of the two or more coil windings coupled by the at least one other joining element of a first ring are circumferentially offset from joining elements of a second ring.

Johansen et al. do not appear to teach such a structure. As seen in FIGS. 2, 4, and 5, Johansen et al. appears to teach a plurality of welds in a single circumferential ring. Erickson et al. do not appear to teach or suggest what Johansen et al. lacks, thus even if one were to combine Johansen et al. and Erickson et al., one would not arrive at the device as claimed. Further, there is no rational reason for one of ordinary skill in the art to modify Johansen et al. and/or Erickson et al. to achieve the claimed device. Reconsideration and withdrawal of the rejection are respectfully requested.

#### **Withdrawn Claims**

For at least the reasons set forth above, the examined claims, some of which are generic, are believed to be in condition for allowance. Applicant respectfully requests rejoinder and consideration of the withdrawn claims 3-5, 12-14, 21-22, 30-31, 38-39, and 44.

**Conclusion**

Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

DAVID J. PARINS

By his Attorney,

Date: \_\_\_\_\_

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